

REMARKS

I. STATUS OF CLAIMS

Claims 1-71 are pending. Claims 60-71 are withdrawn as directed to non-elected subject matter. No claim is amended in this response.

II. REJECTIONS UNDER 35 U.S.C. § 103

The Examiner has rejected claims 1-11, 34-37, and 39-59 under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent 4,927,627 ('627) and U.S. Patent 6,287,543 ('543) or the combination of the '627 patent and U.S. Patent 6,630,131 ('131). The Examiner has also rejected claims 1-59 under 35 U.S.C. § 103(a) as being unpatentable over the combination of the '627 patent and U.S. Patent 6,902,722 ('722), or the combination of the '627 patent and U.S. Patent 6,955,803 ('803), or the combination of the '627 patent and U.S. Patent 7,045,120 ('120), or the combination of the '627 patent and U.S. Patent Application Publication 2004/0074015 (PGPUB '015). Applicant respectfully traverses each rejection as set forth below.

With respect to obviousness, several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. 467; see also *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1730, 82 U.S.P.Q.2d 1385, 1388 (2007).

The Supreme Court, in its recent decision in *KSR Int'l Co. v. Teleflex Inc.*, recognized that a showing of "teaching, suggestion, or motivation" could provide helpful insight in determining whether the claimed subject matter is obvious under Section 103(a). *Id.*, 127 S. Ct. at 1727, 1730, 82 U.S.P.Q.2d at 1385, 1388. In addition, the Supreme Court mandated in *KSR* that "[t]o facilitate review, this analysis [of whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue] should be made explicit." *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Federal Circuit, 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"))).

Following the *KSR* decision, the Office issued a memorandum to its technology center directors on May 3, 2007, indicating that **"in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed."** (Emphasis in original).

In the present case, it is Applicant's position that the Examiner has not met the standards set forth by *Graham* and *KSR*, as discussed below.

A. Rejection under 35 U.S.C. § 103(a) over '627 in view of '543 or '131

The Examiner rejects claims 1-11, 34-37, and 39-59 under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent 4,927,627 ('627) and U.S. Patent 6,287,543 ('543) or the combination of U.S. Patent 4,927,627 ('627) and U.S. Patent 6,630,131 ('131). Office Action at 3. In making this rejection, the Examiner contends that the '627 patent teaches hydrogen peroxide oil-in-water emulsions for bleaching hair but "does not teach having amphiphilic polymer and the hydrophobic unit." *Id.* at 3-4. The Examiner attempts to remedy these deficiencies by relying on the '543 and '131 patents for their alleged teaching of an "amphiphilic polymer of formula I and hydrophobic unit." *Id.* at 4. Applicant respectfully disagrees for at least the following reasons.

With respect to the scope and content of the prior art, the '627 patent lacks several of the presently claimed elements, particularly the presence of at least one hydrophobic unit within the amphiphilic polymer, as noted correctly by the Examiner. Yet, contrary to the Examiner's assertion, neither the '543 nor the '131 patent teaches the use of poly(2-acrylamido-2-methylpropanesulfonic acid) polymers comprising a hydrophobic unit. The Examiner contends that col. 3, lines 24-37 of the '543 patent and col. 4, lines 11-33 of the '131 patent each teach the presently claimed hydrophobic unit. This is simply inaccurate. The '543 patent discloses a cross-linked poly(2-acrylamido-2-methylpropanesulfonic acid) polymer having a unit of formula (I) as presently claimed, but the passage at col. 3, lines 24-37 describes only a preferred set of crosslinking monomers which may be used in the synthesis of the crosslinked poly(2-acrylamido-2-methylpropanesulfonic acid) polymers. No mention is made as to the affinity of these

monomers for water. Indeed, the '543 patent is entirely silent regarding the affinity for water of any of the disclosed crosslinking monomers, and neither teaching nor suggestion can be found as to the consequences of using a hydrophobic rather than hydrophilic crosslinker. To the contrary, the list of appropriate crosslinking monomers recited at col. 3, lines 16-23 of the '543 patent includes several compounds known by those of ordinary skill in the art to be highly hydrophilic. The '543 patent thus provides no suggestion or motivation to use polymers within the scope of the present claims (amphiphilic poly(2-acrylamido-2-methylpropanesulfonic acid) polymers comprising a hydrophobic unit) as opposed to outside of this scope.

The section of the '131 patent cited by the Examiner is similarly directed only to the structure of the crosslinking monomer and is equally silent regarding the affinity for water of any of the crosslinking monomers recited. As in the '543 patent, several compounds known by those of ordinary skill in the art to be highly hydrophilic are recited. Thus, the '131 patent also fails to provide suggestion or motivation for the use of polymers within the scope of the present claims as opposed to outside the scope.

In view of the above arguments, the rejection over the '627 patent in view of the '543 patent or the '131 patent is in error and should be withdrawn.

B. Rejection under 35 U.S.C. § 103(a) over '627 in view of '722

The Examiner has rejected claims 1-59 under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent 4,927,627 ('627) and U.S. Patent 6,902,722 ('722). Applicant respectfully traverses for at least the following reason.

According to the Examiner, because the provisional application upon which the presently examined application relies for benefit was filed in the French language, the relevant date for determining whether a cited patent is prior art over the pending claims is the filing date of the present non-provisional application, October 23, 2003. Office Action at 5. The earliest U.S. filing date of the '722 patent is May 6, 2003, the date of the filing of its provisional application. In order to antedate the '722 patent and remove this rejection, Applicant files herewith a certified English translation of the present application's French priority document, which has a filing date of October 23, 2002.¹

Specifically, M.P.E.P. § 706.02(b) states that a rejection based on §102(e) can be overcome if the foreign priority filing date of the examined application antedates the cited reference *and* the claim for foreign priority is perfected. In the present case, Applicant timely claimed, upon filing of this application, benefit under 35 U.S.C. §119 of French application FR 02/13240, filed in France on October 23, 2002. To now perfect this claim for priority, Applicant submits herewith a certified English translation of FR 02/13240.

In view of this perfection of priority, Applicant submits that the '722 patent is no longer applicable as prior art against the present claims and accordingly, the present rejection should be withdrawn.

¹ Applicant notes that he could alternatively have filed a certified English translation of the provisional application on which the present application claims benefit, but circumstances were more convenient for the translation of the French priority document, with the same end result of removing the '722 patent as a reference.

C. Rejection under 35 U.S.C. § 103(a) over '627 in view of '803 or '120

The Examiner has rejected claims 1-59 under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent 4,927,627 ('627) and U.S. Patent 6,955,803 ('803), or the combination of U.S. Patent 4,927,627 ('627) and U.S. Patent 7,045,120 ('120). Office Action at 5. Applicant respectfully traverses for at least the following reasons.

As an initial matter, the '803 and '120 patents are actually not prior art under 35 U.S.C. § 102(e), given the perfection of priority for the present application established above, and thus cannot be used to support a rejection under 35 U.S.C. § 103. Specifically, for both the '803 patent, which issued from a U.S. continuation application of PCT application No. PCT/FR02/00030, and the '120 patent, which issued from a U.S. continuation application of PCT/FR0200028, the PCT applications were not published in English. Thus, in accordance with M.P.E.P. §706.02(f)(1), both patents are prior art under §102(e) only as of their U.S. filing date. For both patents, this date is July 11, 2003, which does not antedate the priority date of the present application (October 23, 2002). Thus neither patent can qualify as prior art under 35 U.S.C. § 102.

However, both PCT/FR02/00030 and PCT/FR02/00028 published on July 18, 2002, as, respectively, WO 02/055037 and WO 02/055045, and these publications do qualify as prior art under U.S.C. 35 § 102. Applicant thus addresses the Examiner's original rejection over the U.S. counterparts of these PCT publications below, using the counterparts (the '803 and '120 patents) as effective translations of the PCT publications.

In making the rejection, the Examiner contends that the '627 patent teaches hydrogen peroxide oil-in-water emulsions for bleaching hair but "does not teach having amphiphilic polymer and the claimed hydrophobic unit." Office Action at 5. The Examiner attempts to remedy these deficiencies by relying on the '803 and '120 patents for their alleged teaching of an "amphiphilic polymer of formula I and hydrophobic unit" and that "this polymer can be used in cream (emulsions) for hair." *Id.* at 6. Applicant respectfully disagrees for at least the following reasons.

With respect to the scope and content of the prior art, both the '803 and the '120 patents are directed to "photoprotective cosmetic/dermatological compositions well-suited for the UV-photoprotection of human skin and/or hair." See '803 abstract, see *also* '120 abstract. Both patents specifically teach "the use of an amphiphilic polymer containing at least one ethylenically unsaturated monomer containing a sulfonic group, in free form or totally neutralized form, and comprising at least one hydrophobic portion in a photoprotective cosmetic or dermatological composition comprising at least one organic UV-screening agent, for the purpose of increasing its sun protection factor (SPF) and/or its water resistance." '803 patent at col. 3, lines 1-8; see *also* '120 patent at col. 3, lines 9-20. Thus, the '803 and '120 patents clearly teach that adding amphiphilic polymers containing at least one ethylenically unsaturated monomer containing a sulfonic group and at least one hydrophobic portion to skin or hair compositions results in an increase in the water resistance properties of these compositions.

The '627 patent, however, is directed to preparations suitable for use in hair dyeing and hair bleaching applications; specifically, the '627 patent teaches that

preparations according to its invention “may then be applied to the hair at room temperature and rinsed away in the normal way.” ‘627 patent at col. 4, lines 7-8. Thus, one of ordinary skill in the art would have had no motivation or expectation of success for adding amphiphilic polymers according to the ‘803 or ‘120 patents, which increase water resistance, to preparations according to the ‘627 patent, which are meant to rinse easily from the hair. To the contrary, the teachings of the ‘803 and ‘120 patents indicate that such an addition would render preparations according to the ‘627 patent unsatisfactory for their intended purpose. The M.P.E.P. instructs that “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” See M.P.E.P. § 2143.01.V, citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Circ. 1984). Accordingly, the rejection of the instant claims over the ‘627 patent in view of the ‘803 patent or the ‘120 patent is in error and should be withdrawn.

D. Rejection under 35 U.S.C. § 103(a) over ‘627 in view of PGPUB ‘015

The Examiner has rejected claims 1-59 under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent 4,927,627 (‘627) and U.S. Patent Application Publication 2004/0074015 (PGPUB ‘015), also referred to as U.S. Application No. 10/451,409 (‘409) elsewhere in the Office Action. Applicant respectfully traverses for at least the following reason.

As noted by the Examiner, “[c]ommonly assigned 10/451,409 . . . would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly

assigned case qualifies as prior art under 35 U.S.C. 102(e), (f), or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 C.F.R. 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter. A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004." *Id.* at 9.

35 U.S.C. § 103(c)(1) states that "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." The present cases are indeed commonly assigned to L'Oreal and were at the time of invention. In the present application, an assignment to L'Oreal was recorded on April 6, 2004, at Reel 015182, Frame 0202. In the '409 application, an assignment to L'Oreal was recorded on December 1, 2003, at Reel 014745, Frame 0850.

In view of the above, the rejection of the instant claims over the combination of the '627 patent and the '409 application has been overcome and should be withdrawn.

III. PROVISIONAL DOUBLE PATENTING REJECTION

The Examiner has provisionally rejected claims 1-59 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over copending Application No. 10/451,409 in view of U.S. Patent 4,927,627. Applicant respectfully traverses this provisional rejection, at least because no actual double patenting circumstance can arise until a patent issues from the cited application. Since the above copending application is still under consideration, there is the possibility that the claims therein may change. Applicant further requests that any resolution in the form of a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(c), if necessary, be deferred until such patent issues. Accordingly, Applicant respectfully requests that the Examiner withdraw this provisional rejection of the claims.

Applicant also notes that M.P.E.P. § 804 addresses the situation of two copending applications. The section indicates that "[t]he 'provisional' double patenting rejection should continue to be made by the examiner in each application ... unless that 'provisional' double patenting rejection is the only rejection remaining in one of the applications. If the 'provisional' double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the 'provisional' double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent." Applicant submits that in view of the foregoing remarks, the provisional double patenting rejection would be the only rejection remaining in this application. For at least this additional reason, Applicant requests that

any resolution in the form of submission of a Terminal Disclaimer, if necessary, be deferred.

IV. CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is respectfully invited to contact Applicant's undersigned counsel at (202) 408-4454.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: October 29, 2007

By: 

Thalia V. Warnement
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Attachments: Certified English translation of FR 02/13240 prepared by RWS Group Ltd.